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EXAMINER

POINVIL, FRANTZY

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL F. QUINN, JAMES MCGINLAY,
and ROMAN KADRON

Appeal 2009-004094
Application 08/626,600
Technology Center 3600

Decided: February 19, 2010

Before, HUBERT C. LORIN, ANTON W. FETTING, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 37-46 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellants' claimed invention is directed to a trade records information management system. The system stores related documents and messages as electronic images and allows users to retrieve these images in a secure manner. (Spec. 4:6-9). Claim 46, reproduced below, is representative of the subject matter of appeal.

46. A method of managing documents and messages associated with a financial transaction in a system comprising:

scanning at least one paper document associated with the financial transaction to generate at least one image of the at least one paper document at a first site;

transmitting the at least one image in a first format to a first regional processing center; transmitting the at least one image in a second format to a second regional processing center;

retrieving the at least one image at a local trade records information management system from the first regional processing center after determining that the at least one image is not electronically stored at the local trade records information management system;

indexing the at least one image at the local trade records information management system; creating a first transaction folder at the local trade records information management system wherein the first transaction folder contains information related to the financial transaction including the at least one image and messages;

storing the first transaction folder at both the local trade records information management system and the first regional processing center;

retrieving information within the first transaction folder from either the first regional processing center or the local trade records information management system;

wherein a user may access the first transaction folder at the local trade management information system when the regional processing center is off-line; and

wherein a system administrator may restrict the user to access only images from local storage devices.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Cukor	US 5,168,444	Dec. 1, 1992
Wang	US 5,490,217	Feb. 6, 1996
Jacobs	US 5,611,048	Mar. 11, 1997
Burks	US 5,644,778	Jul. 1, 1997
Baker	US 5,696,898	Dec. 9, 1997

Dysart, J., *A Shortcut in the Paper Chase, Distribution*, Vol. 93, No. 1, Jan. 1994, pp. 42-43.

Reding, T., *Digital Imaging Technology: What, Where, and Why in Commercial Nuclear Power*, Nuclear Plant Journal, Vol. 9, No. 4, Jul.-Aug. 1991, pp. 89, 90, 94.

The following rejections are before us for review:

1. Claims 39-41 and 43-46 are rejected under 35 U.S.C. § 103(a) as unpatentable over Cukor, Reding, and Jacobs or Baker and Burks.
2. Claims 37 and 42 are rejected under 35 U.S.C. § 103(a) as unpatentable over Cukor, Reding, and Jacobs or Baker and Burks, and Wang.
3. Claim 38 is rejected under 35 U.S.C. § 103(a) as unpatentable over Cukor, Reding, and Jacobs or Baker and Burks, and Dysart.

THE ISSUE

At issue is whether the Appellants have shown that the Examiner erred in making the aforementioned rejections.

This issue turns on whether the prior art discloses or suggests “scanning at least one paper document” to “generate at least one image of the at least one paper document”.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence:¹

FF1. Burks discloses a medical transaction system that supports processing medical claims without requiring a centralized database or imposing a uniform claim format for healthcare providers or payors (Abstract).

¹ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF2. Burks at Col. 9:26-35 discloses that a disc scanner collects messages from a transmission file and supplies them to a compiler. The compiler retrieves the data from the data fields and organizes the data into a generic data record format.

FF3. Burks at Col. 5:32-35 discloses that the medical transaction system 10 does not communicate with all of the trading partner computer stations in the same data message format nor in the same communication protocol.

FF4. Burks discloses that the extracted data records are formatted in a format that corresponds to a computer identification code that corresponds to a trading partner (Col. 5:50-53).

FF5. Cukor discloses a system for image processing of documents where document images may be captured by scanners at a plurality of remote stations or telefaxed in by individual shippers. The system includes a plurality of image processing stations at which key operators may view the images of shipping documents, and based on the images of the documents, enter transaction data into the shipping transaction database. The system allows for printing of invoices along with a hard copy of any shipping document images which are to accompany the invoices (Abstract).

FF4. Cukor in Fig. 1 shows remote scanning stations (10), an image file server (13), and an invoice printer (connected to data file 31).

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 415-16.

ANALYSIS

The Appellants argue that the rejection of independent claims 44-46 is improper because the claims have limitations directed to an “image” wherein the image is “an image of a paper or hard-copy document and that image is either transmitted or stored in one or more different formats” (Br. 9). The Appellant argues that in contrast that “Burk teaches taking an incoming data message ...and editing and rearranging that data and generating a new and different data message” (Br. 9). The Appellants argue that Burks does not mention receiving the “image” of the paper medical claim form (Br. 10).

In contrast the Examiner has determined that Burk extracts data in one message format to be rearranged in a new format does not create a new document since the information before and after reformatting are the same (Ans. 12). The Examiner acknowledges that in Burk the image formats are different but states that the data contents are not altered or modified (Ans.

13). The Examiner has also determined that Cukor discloses the steps of scanning a document and storing the document as an image file (Ans. 14).

We agree with the Examiner. The Appellants argue that Burk fails to take an image of a paper document, and store or transmit that image in one or more different formats (Ans. 9). However, regardless of this assertion the Examiner has also cited Cukor as disclosing taking the image of the paper document (Ans. 5, 14). We agree with the Examiner that Cukor does teach taking an image of a document (FF5). Burk discloses that data may be transmitted in different formats (FF3) and that extracted data records are formatted in the format that corresponds to the receiving partner (FF4). Thus the prior art has been shown to disclose both scanning documents to get images (Cukor FF5) and transmitting data (images are comprised of data) in different formats (Burk FF3, FF4). As the argued missing claim limitations have been shown in the prior art, the rejection of claims 44-46 and their dependent claims is sustained.

CONCLUSIONS OF LAW

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 39-41 and 43-46 under 35 U.S.C. § 103(a) as unpatentable over Cukor, Reding, and Jacobs or Baker and Burks.

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 37 and 42 under 35 U.S.C. § 103(a) as unpatentable over Cukor, Reding, and Jacobs or Baker and Burks, and Wang.

We conclude that Appellants have not shown that the Examiner erred in rejecting claims 38 under 35 U.S.C. § 103(a) as unpatentable over Cukor, Reding, and Jacobs or Baker and Burks, and Dysart.

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Application 08/626,600

DECISION

The Examiner's rejection of claims 37-46 is sustained.

AFFIRMED

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